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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,733	08/28/2000	Hiroaki Kawamichi	NIT-228	5717

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EXAMINER

ALI, SYED J

ART UNIT	PAPER NUMBER
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2195

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/648,733

Applicant(s)

KAWAMICHI ET AL.

Examiner

Syed J. Ali

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is in response to the amendment filed July 25, 2005. Claims 28-33 are presented for examination.

2. The text of those sections of Title 35, U.S. code not included in this office action can be found in a prior office action.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 28-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

5. As per claim 28, the claim language raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The claimed method recites transmitting a request "in the air" if an event has occurred. Though this limitation appears to be related to a radio transmission, as the claim is presented it could amount to no more than a person telling another person to update data. Claims 29-33 are rejected for at least the same

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reasons as their parent claim, as they fail to present any limitations that resolve the deficiencies of the claim from which they depend.

Claim Rejections - 35 USC § 112

6. **Claims 28-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. For instance, in line 5 of claim 28, the meaning of “acquiring with a number of said elements” is unclear, i.e. what exactly is acquired, or used in the acquisition step. Claim 29 makes very little sense at all, i.e. it is unclear what the “majority” is replaced with. The claims have numerous other grammatical errors that make examination of the claims difficult. Examiner has taken best efforts to interpret the intended meaning of the claims, and has applied prior art according to what the claims appear to convey.

8. Claims 29-33, all depend from cancelled claim 22. It is assumed that these claims were intended to depend from independent claim 28.

9. Claims 28 and 30-33 refer to “IC tags” attached to elements. It is unclear what the acronym “IC” stands for, as neither the claims nor the specification indicate what the acronym

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refers to. It is unclear whether the IC tags are physical tags, i.e. a universal product code, or an “integrated circuit”, or a software module that stores data.

10. Claims 30 and 32 have improper limitations that fail to adequately describe what is included or excluded by the claims. In claim 30, Examiner is unsure of whether the trigger is “entry”, “withdrawal”, or a combination thereof. Similarly, in claim 32 it is unclear whether the common data is a “price”, “effective term”, or a combination thereof.

11. Claim 33 is inconsistent with its parent claim, as it indicates that the sixth step of claim 28 requires information from the eighth step presented in claim 33. This is an impossibility, as the data of the eighth step would not be available for the sixth step, as the sixth step precedes the eighth in execution. The determination in the sixth step would thus be non-functional.

Claim Rejections - 35 USC § 103

12. **Claims 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koizumi et al. (USPN 4,789,986) (hereinafter Koizumi) in view of Donahue et al. (USPN 5,835,721) (hereinafter Donahue).**

13. As per claim 28, Koizumi teaches the invention as claimed, including a data coincident method among IC tags attached on elements, comprising the steps of:

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a first step for determining whether or not a previously defined event as a starting trigger of a coincidence processing has occurred among said IC tags (col. 3 lines 4-10; col. 4 lines 11-21);

a second step for acquiring with a number of said elements if said previously defined event has occurred at the first step (col. 3 lines 10-13; col. 4 lines 13-21, 39-46);

a third step for said IC tags to transmit a coincidence request if said previously defined event has occurred at the first step (col. 5 lines 1-14);

a fourth step for another element to transmit a coincidence request (col. 5 lines 1-14);

a fifth step for said IC tags to transmit a common data to which said coincidence request has been made, responding said coincidence request at the third step or fourth step (col. 5 lines 37-48);

a sixth step for determining whether or not said common data must be updated (col. 5 line 49 - col. 6 line 10); and

a seventh step for updating said common data using a data owned among IC tags in the majority, and return to first step (col. 6 lines 6-36).

14. Donahue teaches the invention as claimed, including transmitting data over a network “in the air”, i.e. by radio communication or other wireless protocols (col. 1 lines 17-21; col. 1 line 57 - col. 2 line 9).

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15. It should be noted that at the time of Koizumi's invention (1986), wireless networking via radio communication was not very common, as the majority of networks were hard-wired. However, this does not preclude the use of wireless network communication to implement the data consistency check method of Koizumi; the capabilities of communication at the time did not allow the system to be implemented in that way. However, wireless networking became more prevalent in the late 1990's, with Donahue presenting a robust system of communicating data over a wired or wireless network (col. 1 lines 17-28). Donahue remedies many of the problems that are well known in the field of wireless networking, including loss of data and interruption of communication (col. 1 lines 29-39). It would have been obvious to one of ordinary skill in the art to combine Koizumi and Donahue, as wireless networks provide numerous advantages over a wired network, including but not limited to ease of installation and reconfiguration, especially over large distances.

16. As per claim 29, Koizumi teaches the invention as claimed, including the data coincident method according to claim 28, wherein said majority is replaced with a largest number of times to be acquired at second step (col. 1 lines 26-29; col. 6 lines 14-29).

17. As per claim 30, Koizumi teaches the invention as claimed, including the data coincident method according to claim 28, wherein said previously defined event as a starting trigger of a coincidence processing is entry/withdrawal of said element or to access to said common data held by said IC tags (col. 3 lines 4-13).

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18. As per claim 31, Koizumi teaches the invention as claimed, including the data coincident method according to claim 28, wherein an acquisition of said number of said elements in the second step, is made by using a survival signal which each IC tags periodically transmits (col. 4 lines 13-46).

19. As per claim 32, neither Koizumi nor Donahue specifically teaches said common data in the fifth step being an element's price or an element's effective term held in said IC tag attached on said element. However, Koizumi teaches storing data that is to be reconciled in a very general sense, i.e. any type of data is supported, depending on the particular needs of the environment in which it is implemented (col. 5 lines 37-48). It would have been obvious to one of ordinary skill in the art that any type of data could be stored in the data fields of Koizumi, including price or effective term, if that is the problem to be solved.

20. As per claim 33, Koizumi teaches the invention as claimed, including the data coincident method according to claim 28, further comprising after fifth step:

an eighth step for said IC tags to receive said common data (col. 5 lines 53-58; col. 6 lines 6-36);

wherein only data obtained at the eighth step are used in a determination at sixth step (col. 5 line 49 - col. 6 line 29).

Response to Arguments

21. Applicant's arguments with respect to claims 28-33 have been considered but are moot in view of the new grounds of rejection.

Conclusion

22. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed J. Ali whose telephone number is (571) 272-3769. The examiner can normally be reached on Mon-Fri 8-5:30, 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T. An can be reached on (571) 272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Syed Ali
September 19, 2005



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